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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91224436
Party	Plaintiff Joan Herlong
Correspondence Address	TIMOTHY D ST CLAIR NEXSEN PRUET LLC 55 E CAMPERDOWN WAY STE 400 GREENVILLE, SC 29601 UNITED STATES tstclair@nexsenpruet.com, pweaver@nexsenpruet.com
Submission	Opposition/Response to Motion
Filer's Name	TIMOTHY D. ST. CLAIR
Filer's e-mail	tstclair@nexsenpruet.com, pweaver@nexsenpruet.com
Signature	/Timothy D. St. Clair/
Date	02/01/2016
Attachments	Opposer's Brief In Opposition.pdf(94347 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Trademark
Serial No. 86/577749
Filing Date: March 26, 2015
Mark: NUMBER ONE IN THE NEIGHBORHOOD
Publication Date: August 18, 2015

Joan Herlong, Opposer, v. Sharon Wilson, Applicant.	Opposition No. 91224436

OPPOSER'S BRIEF IN OPPOSITION TO APPLICANT'S MOTION TO DISMISS

Opposer hereby opposes Applicant's Rule 12(b)(6) Motion to Dismiss.

I. LEGAL STANDARD

"A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of a complaint. In order to withstand such a motion, a complaint need only allege such facts as would, if proved, establish that the plaintiff is entitled to the relief sought, that is, that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for denying the registration sought (in the case of an opposition), or for canceling the subject registration (in the case of a cancellation proceeding). To survive a motion to dismiss, a complaint must 'state a claim to relief that is plausible on its face.'" TBMP § 503.02.

Rule 8 governs the sufficiency of the pleadings, which requires only "a short and plain statement of the claim showing that the pleader is entitled to relief." FED.R.CIV.P. 8(a)(2). The purpose of the requirement is to "give the defendant fair notice of what … the claim is and the grounds upon which it rests." *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 555 (2007) (citations omitted).

Rule 8 only requires that a claim be plausible, not that each and every element be distinguished in a complaint. See FED.R.CIV.P. 8; *see also A.G. ex rel. Maddox v. v. Elsevier, Inc.*, 12-1559, 2013 WL 5630077 at *4 (1st Cir. Oct. 16, 2013) ("the plausibility standard should be applied to the claim as a whole"); *Arista Records, LLC v. Doe 3*, 604 F.3d 110, 120-21 (2nd Cir. 2010) ("Accordingly, although *Twombly* and *Iqbal* require factual amplification where needed to render a claim plausible, we reject Doe 3's contention that *Twombly* and *Iqbal* require the pleading of specific evidence or extra facts beyond what is needed to make the claim plausible") (internal citations omitted); *Burnett v. Mortgage Electronic Registration Systems, Inc.*, 706 F.3d 1231, 1236 (10th Cir. 2013) (stating that a Plaintiff is not required to set forth a prima facie claim for relief).

Notice pleading obviates the need to allege particular "magic words." *Fair Indigo LLC v. Style Conscience*, 85 U.S.P.Q.2d 1536, 1538 – 39. "[T]o survive a motion to dismiss, a complaint must contain sufficient factual matter, accepted as true, to state a claim to relief that is plausible on its face." *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (internal citations omitted).

As observed in *Rodriguez-Reyes v. Molina-Rodriguez*, 711 F.3d 49, 54 (1st Cir. 2013):

> "In a nutshell, the elements of the prima facie case may be used as a prism to shed light on the plausibility of the claim. Although a plaintiff must plead enough facts to make entitlement to relief plausible in light of the evidentiary standard that will pertain at trial … she need not plead facts sufficient to establish a prima facie case."

As the Board noted in *Fair Indigo*, "As is often stated, the purpose of notice pleading is to obviate the need to allege particular 'magic words.'" *Fair Indigo*, 85 U.S.P.Q.2d at 1538.

All of Opposer's well-pleaded allegations must be accepted as true, and the notice of opposition must be construed in the light most favorable to Opposer. *See Fair Indigo*, 85 U.S.P.Q.2d at 1538.

II. ARGUMENT

Applicant has not disputed that Opposer has adequately and sufficiently alleged that she has standing to maintain the proceeding. Thus, Applicant's challenge hinges only on whether Opposer has alleged that a valid ground exists for opposing the subject registration.

When the allegations in the Petition are read as a whole, Opposer has alleged "enough facts to make entitlement to relief plausible in light of the evidentiary standard that will pertain at trial." *Rodriguez-Reyes v. Molina-Rodriguez*, 711 F.3d at 54. Applicant's argument is that Opposer has failed to use "magic words" to establish the elements she will be required to prove at trial. This is not the legal standard and is contrary to Rule 8 notice pleading.

Applicant argues that no claim has been asserted for deceptive misdescription because the claim "Number One in the Neighborhood" is incapable of being proven true or false. Applicant misapprehends the standard of FED.R.CIV.P. 12(b)(6). "Proof" is an evidentiary standard, not a pleading standard. Opposer alleges that Applicant's claim is false [Amended Petition, ¶¶ 8, 10] and such is sufficient to overcome Applicant's FED.R.CIV.P. 12(b)(6) motion. Applicant's argument therefore fails.

Moreover, Applicant's argument is a false argument. If Applicant's "Number One in the Neighborhood" could be shown to be true, it can likewise be proven to be false. And, if it were true, it could be shown to be true. Were Applicant "Number One in the Neighborhood," she would not hesitate to so assert. If Applicant, in any relevant market over any relevant time period, (1) had the highest number of sales, or (2) had the greatest number of listings, or (3) had listings that sold faster than those of other real estate agents or (4) had listings that sold at a higher price than those of other real estate agents or (5) had services of superior quality compared to those of other real estate agents, or (6) had services of enhanced performance or function compared to those of other real estate agents, or (7) could point to any other known, pertinent metric by which Applicant is the best, most desirable, finest, first, greatest, highest, maximum, paramount, preeminent, superlative, top, ultimate, unsurpassed, utmost, or otherwise "number one" real estate agent, Applicant could prove her assertion to be sufficiently true, that indeed she is "Number One in the Neighborhood." But she cannot, because it is not true.

Logically, then, if Applicant's assertion could be proven to be true, which it could were it true, it can likewise be proven to be false. Applicant's argument therefore fails.

In her Amended Petition, Opposer alleges that a purchaser of Applicant's services assumed that Applicant's phrase "Number One in the Neighborhood" actually described Applicant's services [Amended Petition, ¶ 16(a)] and that (1) prospective real estate sellers and purchasers are likely to believe that Applicant's misdescription applies to Applicant's services in their neighborhood or neighborhoods of interest [Amended Petition, ¶ 12] and that (2) Applicant's misdescription is likely to materially affect a significant portion of prospective real estate sellers' and purchasers' decision to procure Applicant's services and would likely be a material factor in the purchasing decision of a significant portion of the relevant consumers of such services [Amended Petition, ¶ 13]. Proof of those allegations awaits the merits phase of this Opposition; it is sufficient now that Opposer has alleged them. Applicant's argument therefore fails.

In her Amended Petition, Opposer alleges that Applicant's deceptive misdescription actually affected a purchaser's decision to purchase Applicant's services. [Amended Petition, ¶ 16(a)]. Opposer has thereby included factual allegations that make it plausible that Applicant's misdescription is likely to affect a potential purchaser's decision to purchase Applicant's services. Applicant's argument therefore fails.

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For a complaint to be legally sufficient, a plaintiff need only allege sufficient factual matter as would, if proved, establish that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for opposing or cancelling the mark. *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). Specifically, "a complaint must contain sufficient factual matter, accepted as true, to state a claim to relief that is plausible on its face." *Ashcroft, supra*. In

deciding such a motion, "the Board ... must accept as true all material allegations of the complaint, and must construe the complaint in favor of the complaining party." *Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2023 (Fed. Cir. 1987). In addition, under the simplified notice pleading requirements of the Federal Rules of Civil Procedure, the allegations of a complaint are construed liberally "so as to do substantial justice." FED.R.CIV.P. 8(e); *Scotch Whisky Assoc. v. United States Distilled Products Co.*, 952 F.2d 1317, 21 USPQ2d 1145, 1147 (Fed. Cir. 1991).

Whether or not petition can prevail on this claim is a matter for resolution on the merits at trial or upon motion for summary judgment. *See Flatley v. Trump*, 11 USPQ2d 1284 (TTAB 1989). Therefore, Applicant's claim of bias on the part of one of the affiants referenced in Opposer's Amended Petition [Applicant's Motion, p. 8], as well as Applicant's other general complaints and arguments, have no place in the motion before the Board. From a pleading perspective, Opposer's Amended Petition is sufficient.

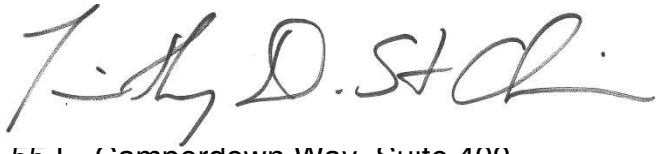
By these standards, Applicant's argument fails.

III. CONCLUSION

Opposer respectfully requests that the Board deny Applicant's Motion to Dismiss in its entirety and accept as filed Opposer's Amended Petition for Opposition.

Respectfully submitted,

NEXSEN PRUET, LLC



February 1, 2016

55 E. Camperdown Way, Suite 400
Greenville, South Carolina 29601
Telephone: (864) 282-1181
Facsimile: (864) 477-2634
e-mail: tstclair@nexsenpruet.com

ATTORNEYS FOR OPPOSER

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I, Timothy D. St.Clair, attorney of Nexsen Pruet, LLC, attorneys for Opposer, hereby certify that a true, correct, and complete copy of the foregoing

OPPOSER'S BRIEF IN OPPOSITION TO APPLICANT'S MOTION TO DISMISS

was served on Applicant's attorney of record at the following address:

Thomas L. Moses
Southeast IP Group LLC
P. O. Box 14156
Greenville, South Carolina 29610

postage prepaid by first-class mail on February 1, 2016.

Executed on February 1, 2016 at Greenville, South Carolina.